

REMARKS

With this amendment: claims 1-9, 11, 14-20, and 22 are canceled; claims 10, 13, 21, and 23 are amended; claim 12 remains unchanged; and claim 24 is newly added. Less than 20 claims are pending and exactly three independent claims are presented. Thus no excess claims fees are due with this amendment. A one month extension of time is requested in the prior application so this RCE is timely.

Applicant respectfully traverses the USPTO's rejection mailed October 7, 2003. Applicant believes that certain claim terms are being misconstrued by the USPTO and for this reason amends the claims in an attempt to make them more clear and address certain items the USPTO believes are obvious over what has been identified as the Yant, Brandon, and Gates references.

Primarily, the amendments focus on two points. First, the claims are directed to an insert that can be removably inserted and taken from a shoe. An insert as used in the claims does not mean that the insert is part of the rigid shoe construction and therefore integral to the shoe. If the claims were not clear before, then Applicant's amendments (e.g., "removably") should clear up this misunderstanding. While Yant (US6178664) teaches that a multilayer protective layer is constructed, Brandon (US4942679) is a shoe construction. The multi-layered design of Yant and Brandon's integrated shoe construction approach are precisely contrary to each other and to what Applicant claims. The Yant and Brandon approaches create the very problems solved by Applicant's removable single stainless steel sheet solution, for example deterioration, which is discussed at paragraph 30 of Applicant's written description.

Second, Applicant has amended the claims to make clear that a single sheet of stainless steel having specific properties is what is claimed, as well a single cushion layer. Yant discloses a multiple steel sheet embodiment, which further have properties outside of the those required in Applicant's claims. Gates, while an insert, is completely vague on specifics. What is disclosed by Gates, however, is a non-uniform protective layer (8) (see Gates figures 1 and 2) turned back at one end so as to form a cup-like enclosure encasing the toes of the wearer. However, all of

Applicant's claims require that the single stainless steel sheet be flat and be of a uniform thickness of between 0.020 and 0.025 inches. Furthermore, Applicant's close-ended construction preclude the cup-like enclosure of Gates, and indeed a single curvilinear steel sheet.

Setting aside argument on the specific teachings of the references, Applicant does not see, nor has the USPTO explained, the motivation to combine the references cited in the Office action. Specifically, Applicant believes that one would not be motivated to combine "insert" art with "integral shoe construction" art. It is not clear in the USPTO's combination of Yant and Brandon or Gates and Brandon why one would have been motivated to so combine and so modify the references, as the USPTO suggests, to yield what Applicant claims. This is inappropriate hindsight analysis. See, e.g., *In re Roufett*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) ("[R]ejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.'") Applicant has explained, for example at paragraph 30 of the written description, the problems with the integral shoe construction approach and why it is antithetical to Applicant's invention. For this reason, Applicant does not believe that one of skill in the art would combine the two approaches.

Applicant respectfully disagrees with the characterizations and statements made in the last paragraph of section 5 of the USPTO indicating Applicant's arguments are not true. Applicant requested analysis and explanation concerning certain rejected claims. Applicant did not dispute that the USPTO rejected the claims.

Applicant respectfully asserts that, for the reasons cited above, Brandon does not make up the difference where Yant and Gates fall short, even assuming Brandon can be combined with Yant or Gates. Specifically, Applicant believes that their pending claims are distinguishable from the what the references cited by the USPTO, and should be allowed.

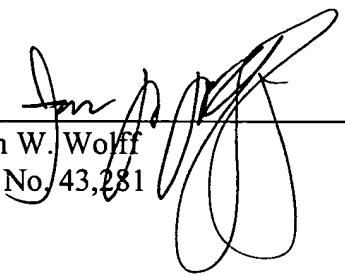
Applicant : Blackburn, et al.
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Enclosed is a \$385 check for a Request for Continued Examination (RCE) Under 37 C.F.R. §1.114 being filed concurrently herewith and a \$55 check for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: 2/5/04



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